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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/690,563

10/23/2003

Frederic Legrand

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09/03/2009

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER

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EXAMINER

VENKAT, JYOTHSNA A

ART UNIT

PAPER NUMBER

1619

MAIL DATE

DELIVERY MODE

09/03/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/690,563

Applicant(s)

LEGRAND, FREDERIC

Examiner

JYOTHSNA A. VENKAT

Art Unit

1619

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Receipt is acknowledged of amendment and remarks filed on 5/8/09.

Status of claims

Claims 60-71 are withdrawn from consideration as being drawn to non-elected invention (election with traverse dated 3/16/07). Claims 1-59 are examined in the application.

In view of the amendment, the rejection of claims 23-24 and 26-27 under 112, second paragraph is hereby withdrawn. The obviousness-type double patenting rejection is maintained and in response to obviousness-type double patenting rejection, applicants state that they will file terminal disclaimer over U. S. patent 7,338, 534 and also over co-pending application at the time of indication of allowable subject matter in the instant application.

Claim Rejections - 35 USC § 103

Claims 1-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of WO 02/051,369 ('369) and U.S. Patent 4,927, 627 ('627).

The examiner is relying on English equivalent of WO document, which is PGPUB US 2004/0074015 ('015). Applicant's submitted certified English translation of foreign priority document on 10/29/07. The publication date of WO document is July 4, 2002 and this date is before the effective filing date of the instant application, which is October 23, 2002.

PGPUB '015 teaches oxidizing compositions using claimed cross-linked amphiphilic polymer and claimed hydrophobic unit. See paragraphs 27-88 for detailed description of the claimed amphiphilic polymer and claimed hydrophobic unit (claims 2-16). See paragraphs for detailed description of the oxidizing agent and see paragraph 97 for the claimed stabilizer, see paragraphs 218-220 for anionic and non-ionic surfactants.

PGPUB teaches the limitations of claims 17-22 at paragraphs [0067-0079], teaches the limitation of claim 23 at paragraphs [0051-0053], teaches the limitation of claims 24 at paragraph [0054], teaches the limitation of claim 25 at paragraph [0055], teaches the limitations of claims 26-29 at paragraphs [0058-0059], teaches the limitations of claims 31-36 at paragraphs [0080-0082], teaches the limitations of claims 37-43 at paragraphs [0089-0091], teaches the limitations of claims 44-46 at paragraph [0094], teaches the limitations of claims 52-54 at paragraphs [0216-0232], teaches the limitation of claim 60 at paragraph [0096], teaches the limitations of claims 56-58 at paragraphs [0097], teaches the limitations of claims 55-56 at paragraphs [0253]. The difference between WO document and instant application is WO document does not teach oxidizing oil-in-water emulsion and claimed fatty alcohol.

Patent '627 teaches hydrogen peroxide emulsions for bleaching hair. Patent teaches at col.2, lines 34-45 teaches hydrogen peroxide in the form of oil-in-water (o/w) emulsions and at col.3, line 18 teaches the concentration of the hydrogen peroxide, which is the oxidizing agent claimed. Patent at col.2, lines 51-65 teach anionic and nonionic surfactant and mixture of these surfactants. See also col.3, lines 8-17. Patent at col.2, lines 56-50 teaches the claimed fatty alcohols and in examples teaches cetyl alcohol claimed. Patent at col.3, under (f) teaches claimed stabilizers and under (g) teaches adding buffer agents so that pH is 3-5. See examples for additives.

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the compositions of 'WO document using having oxidizing agent, surfactant, stabilizer, amphilic polymer of formula I and hydrophobic unit and combine it with fatty alcohol expecting beneficial effect. One of ordinary skill in the hair care art would be

motivated to prepare the compositions in the form of cream emulsion with the reasonable expectation of success that it is easier to apply the bleaching compositions in the form cream instead of hydrous as the compositions can be applied onto hair easily and it won't run off and bleaching the hair can be performed effectively. One of ordinary skill in the art would be motivated to add fatty alcohol in emulsions with the reasonable expectation of success that the viscosity of the emulsions can be controlled by means of fatty alcohol. This is a prima facie case of obviousness.

Response to Arguments

Applicant's arguments filed 5/8/09 have been fully considered but they are not persuasive.

Applicant's argue that WO '369 teaches away from using ant other formulations beside transparent gel and WO '369 at [0011] discourages the use of any other formulations and since WO '369 clearly limits itself to transparent gels, the disclosure of WO '369 does not motivate, but actually leads away from the '627 patent which teaches the use of cream emulsions.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

PGPUB which is English equivalent of WO '369 at [0003] teaches that bleaching compositions are mainly in the form of powders or creams. Thus the claimed formulations have been conventionally used for bleaching keratin fibers. WO '369 teaches gel formulations but this does not mean that WO '369 teaches away from the claimed emulsions. Gels, powders and

creams are all drawn to different formulation types. Therefore one of ordinary skill in the hair care art would prepare the compositions of 'WO document using oxidizing agent, surfactant, stabilizer, amphiphilic polymer of formula I and hydrophobic unit and combine it with fatty alcohol taught by patent '627 and use it in the form of oil-in-water emulsions taught by patent '627 for bleaching keratin fibers and also admitted by PGPUB at [003] that creams which are emulsions have been used for bleaching keratin fibers with the reasonable expectation of success that which exhibit improved depth of color and brightness taught by patent '627 at col.1, ll 53-64.

Thus claims are prima facie obvious within the meaning of 35 U.S.C. 103 over the combination of WO 02/051,369 ('369) and U.S. Patent 4,927, 627 ('627).

Conclusion

This application contains claims 60-71 drawn to an invention nonelected with traverse in the reply filed on 3/16/07. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JYOTHSNA A VENKAT /
Primary Examiner, Art Unit 1619